



MS Amendment
Attorney Docket: 25854

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

BREDESEN

Confirmation No. 4474

Serial No. 10/725,923

Group Art Unit 1734

Filed: December 3, 2003

Examiner: Y. Tadesse

Title: **METHOD AND DEVICE FOR SEPARATE APPLICATION**

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action having a mailing date of February 8, 2005. The one-month shortened statutory period to respond was set to expire March 8, 2005, making this a timely filed response to the outstanding Office Action.

In view of the following election and remarks, the Applicant respectfully requests that the Examiner conduct a first substantive examination of the application.

REMARKS

Claims 1 – 18 are pending in the application and are presented for a first substantive examination on the merits.

In the outstanding Office Action, claims 1 – 18 were subjected to a restriction requirement.

By this Response to Restriction Requirement, an election with traverse, is made.

Restriction Requirement Summary

The Examiner has required restriction of claims 1 – 18 to a single invention under 35 U.S.C.

§121. Claims 1 – 18 were subjected to a Restriction Requirement as follows:

Group I: claims 1 – 5 and 8 – 18 are asserted to be drawn to a device for application of a gluing system; and

Group II: claims 6 – 7 are asserted to be drawn to a method of avoiding plugging one or more orifices.

Response

Applicant provisionally elects to continue prosecution of Group I, claims 1 – 5 and 8 – 18, and respectfully traverses the Examiner's restriction with respect to Groups I – II.

The method of claims 6 and 7 is a method that can be used in a device as claimed in claim 1. Thus, it is respectfully submitted that there is no serious burden to examine both groups of claims. Under MPEP §803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Due to the similarity of the features of the Groups, a search of each of the inventions of the Groups would be coextensive and, therefore, it is respectfully submitted that it would not be a *serious* burden upon the Examiner to examine all of the claims in this application. Regardless of any differences which may exist between the inventions set forth in the different claims, a complete and thorough search for the invention set forth in any one of the claims would require searching the art areas appropriate to the other claims.

Further, at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims. Considering that the

Examiner will most likely undertake a search for the apparatus of Group I, searching for the method of related Group II would be minimally burdensome on the Examiner in view of the fact that both Groups share similar features.

Moreover, given the overlapping subject matter of the Groups, examinations of both of the invention groups would not pose a serious burden because they would be coextensive. Further, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

Furthermore, Applicant has paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring Applicant to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing the Applicant to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

In view of the foregoing, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

CONCLUSION

In light of the foregoing, Applicant respectfully requests that the Examiner conduct a first substantive examination of the application. If the Examiner has any questions or comments regarding this matter, he is welcomed to contact the undersigned attorney at the below-listed number and address.

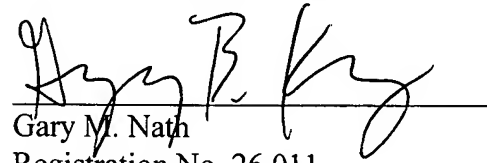
In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,
NATH & ASSOCIATES PLLC

Date: March 3, 2005

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